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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,803	01/21/2005	Don R Jorgenson	Jorgenson-USNP	3776
33549 7590 08/08/2008 SANTANGELO LAW OFFICES, P.C. 125 SOUTH HOWES, THIRD FLOOR FORT COLLINS, CO 80521			EXAMINER THOMPSON, MICHAEL M	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 08/08/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/521,803	Applicant(s) JORGENSEN, DON	
	Examiner Michael M. Thompson	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-21-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 213-241 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 213-241 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-21-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claims 213-227, several terms for example, “digital identities,” “Master Business Associate Contract template,” “covered entities,” “multilateral contractual agreements”, “MBAC database,” “self-certification provisions,” appear to lack support in the specification. With respect to the “interactive means” and “means for a covered entity,” “non-negotiable terms,” “self-certified covered entities,” “self-certified business associates,” “electronic signature,” “affidavit,” etc., 37 CFR 1.75(d)(1) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” While the above list is not exhaustive, applicant should review the above claims for all other terms lacking antecedent support. No new matter should be added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 213-227 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When the examiner considers the “digital identities,” “Master Business Associate Contract template,” “covered entities,” “multilateral

contractual agreements", "MBAC database," "self-certification provisions," appear to lack support in the specification. With respect to the "interactive means" and "means for a covered entity," "non-negotiable terms," "self-certified covered entities," "self-certified business associates," "electronic signature," "affidavit," etc., the scope of the claims are unclear so as not to insure that the public is informed of the boundaries of what constitutes infringement of the patent. Furthermore, it is unclear as to what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 213-241 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis. (US 2004/0015432).**

6. **With respect to claims 213-227**, Lewis generally teaches identical limitations in claims 1-15.

7. **With respect to claims 228-241**, Lewis teaches all of the limitations of the claims, specifically:

8. **With respect to claim 228**, Lewis teaches a method for creating and managing contractual relationships among interacting parties under a privacy standard, said interacting parties comprising (1) "covered entities" and (2) "business associates" between which private information is exchanged, said method comprising the steps of: issuing digital certificates(i.e. digital identities) to the interacting parties (i.e. contracting parties); providing community rules (i.e. MBAC) having a minimum standard based on said privacy standard (i.e. HIPAA non-negotiable terms) requiring compliance (i.e. observation) of said privacy standard with respect to said private information (i.e. private data); providing an electronic interface accessible to said interacting parties to facilitate negotiating and entering binding agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said community rules; and storing said binding agreements in a database. (i.e. similar to claim 1).

9. **With respect to claim 229**, Lewis teaches the method according to claim 228, further comprising the step of providing certificates of compliance certifying that said interacting parties comply with said community rules. (i.e. self-certification provisions and covered entities/business associates of claim 2).

10. **With respect to claim 230**, Lewis teaches the method according to claim 228, wherein said electronic interface facilitates negotiating additional requirements with respect to use or disclosure of said private information. (i.e. claim 3).

11. **With respect to claim 231**, Lewis teaches the method for creating and managing contractual relationships among interacting parties under a privacy standard,

said interacting parties comprising (1) "covered entities" and (2) "business associates" between which private information is exchanged, said method comprising the steps of: issuing digital certificates to the interacting parties (i.e. digital identities); providing community rules (i.e. MBAC) having a minimum standard based on said privacy standard (i.e. HIPAA non-negotiable terms) requiring compliance (i.e. observation) of said privacy standard with respect to said private information (i.e. private data); providing certificates of compliance certifying that said interacting parties comply with said community rules (i.e. self-certification provisions and covered entities/business associates); providing an electronic interface accessible to said interacting parties to facilitate negotiating and entering binding agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said community rules; and storing said binding agreements in a database. (i.e. substantially claim 4).

12. **With respect to claim 232**, Lewis teaches the method according to claim 231, wherein said step of providing certificates of compliance comprises the steps of: validating said certificate of compliance (i.e. self-certification by electronically signing self-certification affidavit); and storing said certificate of compliance in said database. (i.e. claim 5).

13. **With respect to claim 233**, Lewis teaches the method according to claim 231, wherein said electronic interface facilitates negotiating additional requirements with respect to use or disclosure of said private information. (i.e. claim 7).

14. **With respect to claim 234**, Lewis teaches the method according to claim 231, wherein said electronic interface (i.e. electronic interface, interactive means) facilitates a covered entity to offer and a business associate to accept said community rules having said minimum standard. (i.e. claim 7 and 8).

15. **With respect to claim 235**, Lewis teaches the method according to claim 231 further comprising the step of querying a target member (i.e. multilateral contractual agreement) for permission to disclose selected private information to said target member (i.e. self-certified business associate).

16. **With respect to claim 236**, Lewis teaches the method according to claim 231, wherein said electronic interface comprises the internet. (i.e. claim 10).

17. **With respect to claim 237**, Lewis teaches the method for creating and managing contractual relationships among interacting parties under a privacy standard applicable to protected health information (PHI), said interacting parties comprising (1) "covered entities" and (2) "business associates" between which private information is exchanged, said method comprising the steps of: issuing digital certificates to the interacting parties (i.e. (a)); providing community rules having a minimum standard based on said privacy standard requiring compliance of said privacy standard with respect to said PHI (i.e. (b)); providing an electronic interface accessible to said interacting parties to facilitate negotiating and entering binding agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said community rules (i.e. (e)); providing an agreement for said interacting

parties to certify adherence to said privacy standard by electronic signature (i.e. (c));
and storing said agreement in a database (i.e. (d)).

18. **With respect to claim 238**, Lewis teaches the method according to claim 237, wherein said electronic interface facilitates negotiating additional requirements with respect to use or disclosure of said PHI. (i.e. claim 12).

19. **With respect to claim 239**, Lewis teaches the method according to claim 237, wherein said electronic interface facilitates a covered entity to offer and a business associate to accept said community rules (i.e. MBAC non-negotiable terms) having said minimum standard. (i.e. claim 13).

20. **With respect to claim 240**, Lewis teaches the method according to claim 237, further comprising the step of querying a target member (i.e. signed contractual agreements in MBAC database) for permission to disclose selected PHI to said target member (self-certified entity/identity such as business associate). (i.e. claim 14).

21. **With respect to claim 241**, Lewis teaches the method according to claim 237, wherein said electronic interface comprises the internet. (i.e. claim 15).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. **Claims 213-217 and 219-227 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keinsley et al. (US 2003/0154403) in view of Smithies (5,818,955) and further in view of 65 Fed. Reg. 82796 (Dec. 28, 2000).**

24. **With respect to claims 213, 214, 216, 228-229, and 231,** Keinsley et al. teaches a method for creating and managing multilateral contractual relationships (i.e. Para. 0176) among contracting parties under a privacy standard (ie. HIPAA regulations inherently require privacy standards, i.e. Para. 0118-0121), said contracting parties comprising (1) "covered entities" receiving data of customers and creating, recording, using, and disclosing private data of such customers in the ordinary course of business, and (2) "business associates" requiring the use of said private data (i.e. Para. 0176), said method comprising the steps of: assigning digital identities/certificates to the contracting/interacting parties and providing certificates/self-certifications (ie. Para. 0117-0118 and 0164); generating a database of digital identities (i.e. Para 0166-0168 or 0695); providing an electronic interface (ie. Para 0117) accessible to said digital identities/certificates **to facilitate** negotiating and entering binding multilateral contractual agreements/agreements among at least one of said covered entities and a plurality of said business associates pursuant to the terms of said MBAC template/community rules; and storing said multilateral contractual agreements or binding agreements in a database (i.e. Para. 0088). Keinsley et al. also teaches that contracting parties can be prompted with legal agreements upon signing in to a system as a user, (as identified above in the certification/MBAC template agreement references above). Keinsley et al also teaches that new or other legal agreements or conditions

can be added for which the user will have to agree (i.e. Para. 0615). In the least, Keinsley et al. teaches prompting of multiple agreements upon signing into a HIPAA database.

With respect to claims 214, 216, 229, and 231, Keinsley et al. fails to teach the additional step of providing self-certification provisions/certificates of compliance in said MBAC/community rules for contracting/interacting parties to certify adherence to said privacy standard. However, Smithies provides a document and signature verification system including a sample self-certification or certificate of compliance type form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification/certificate of compliance forms can be modified to adhere to any contractual agreement or community rule. It would have been obvious to one of ordinary skill in the art, at the time of invention of electronic contractual agreements/community rules to modify the Keinsley et al. legal agreements to include self-certification and electronic signature or certificates of compliance to certify compliance as taught by Smithies for the fact that self-certification and certificates of compliance allow for the formation of agreements that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

With respect to claims 213, 216, 228, and 231, Keinsley et al. also does not appear to explicitly recite providing a multilateral Master Business Associate Contract (MBAC) template having non-negotiable terms or community rules having a minimum standard, requiring observation/compliance of said privacy standard with respect to said private data of a customer. The Federal Registrar teaches that Federal rules require

non-negotiable terms or “community rules” that require observation/compliance with privacy standards with respect to customer data. For example, Section 164.530 requires an entity to maintain specific policies and procedures in written or electronic form to protect health information. It would have been obvious to one skilled in the art of contractual agreements or “community rules” to modify the method for creating contracts of Keinsley et al. with the non-negotiable terms or minimum standards for community rules as taught by the Federal Registrar in order to protect the privacy of the medical data of customers. Motivation is evident based on the fact that these agreements are common and any automation would save a great deal of time.

25. **With respect to claims 215, 219, 230, and 233**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teach all of the limitations of claims, such that Keinsley et al. specifically teaches an electronic interface including interactive means for negotiating additional terms with respect to use or disclosure of said private data. (i.e. Para 0117). It should be noted that given the objection and rejections above, the examiner has interpreted interactive means under its broadest reasonable interpretation. Simply the language is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

26. **With respect to claims 217 and 232**, the combination of Keinsley et al., teaches all of the limitations of claims, including signing an agreement (i.e. Para. 0622), except for explicitly reciting that additional step of providing self-certification provisions/certificates of compliance in said MBAC/community rules for contracting parties to certify adherence to said privacy standard by providing a self-certification

affidavit for self-certification by electronic signature/validation and storing the affidavits/certificates of compliance in a database.

However, Smithies provides a document and signature verification system including a sample self-certification/certificate of compliance form (Fig. 3A). While the sample form does not explicitly state adherence to said privacy standard, it is clear that the self certification/compliance forms can be modified to adhere to any contractual agreement or community rule established. It would have been obvious to one of ordinary skill in the art, at the time of invention of electronic contractual agreements and community rules to modify the Keinsley et al. legal agreements/rules related to privacy of HIPAA regulations to include self certification with electronic signature or certificate of compliance validation as taught by Smithies for the fact that self-certification and validation allows for agreements/rules that would otherwise not be binding to become binding in a quick, inexpensive, and efficient way.

27. **With respect to claim 223 and 237**, these claims introduces no substantial limitation over claims 213, 216, 217, 228, 231, and 232 respectively, and is therefore rejected under a similar rational.

28. **With respect to claims 220, 225, 234, and 239**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 216, 223, 231 and 237 such that Keinsley et al. specifically teaches an interactive means includes means or electronic interface for a covered entity to offer and for a business associate to accept said non-negotiable terms in the MBAC or community rules having a minimum standard. (i.e. Para 0117, providing for a computer capable of facilitating the offer and

acceptance). It should be noted that given the objection and rejections above, the examiner has interpreted interactive means under its broadest reasonable interpretation. Simply the language is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

29. **With respect to claims 221, 226, 235, and 240**, the combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 216 and 223, such that Keinsley et al. inherently teaches the additional step of: accessing a selected multilateral contractual agreement in said MBAC database or querying a target member for permission to disclose selected private data/information to, for example, a selected self-certified business associate. In fact, the determination of whether a user has agreed to contractual agreement/rules is contingent upon knowing whether your user is authorized. For example, Keinsley teaches storing your agreement. (i.e. Para. 0690 and 0695).

30. **With respect to claims 222, 227, 236, and 241**, in the least Keinsley et al. teaches an electronic interface comprising the internet. (i.e. Para 0117).

31. **With respect to claim 224, 238, the** combination of Keinsley et al., Smithies and 65 Fed. Reg. 82796 teaches all of the limitations of claims 11, such that Keinsley et al. specifically teaches an electronic interface including interactive means/electronic interface for negotiating additional terms with respect to use or disclosure of said PHI data. (i.e. Para 0117; PHI data is the data being stored in HIPAA context). It should be noted that given the objection and rejections above, the examiner has interpreted “interactive means” under its broadest reasonable interpretation. Simply the language

is interpreted to be a computer or otherwise that is connected to the web/internet capable of facilitating additional negotiation.

32. Claim 218 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keinsley et al. (US 2003/0154403) in view of Smithies (5,818,955) and 65 Fed. Reg. 82796 (Dec. 28, 2000) as applied to claim 4 above and further in view of Examiner's Official Notice.

33. As per claim 218, Examiner takes Official Notice that warranty clauses are extremely old and well known in the art of contract negotiations. It would have been obvious to one skilled in the art, at the time of invention for contract negotiations to have a warranty clause in the MBAC since the creation of a warranty clause allows for more complete negotiation and prevents future litigation.

Conclusion

The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571)

Art Unit: 3629

270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629
July 31, 2008

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629